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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/560,655

08/11/2006

Paul D. Olivo

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THOMPSON COBURN, LLP  
ONE US BANK PLAZA  
SUITE 3500  
ST LOUIS, MO 63101

EXAMINER

SNYDER, STUART

ART UNIT

PAPER NUMBER

1648

NOTIFICATION DATE

DELIVERY MODE

12/12/2008

ELECTRONIC

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

IPDOCKET@THOMPSONCOBURN.COM

<b>Office Action Summary</b>	<b>Application No.</b> 10/560,655	<b>Applicant(s)</b> OLIVO ET AL.	
	<b>Examiner</b> STUART W. SNYDER	<b>Art Unit</b> 1648	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 2 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 25 September 2008.
- 2a) ☐ This action is **FINAL**.                      2b) ☐ This action is non-final.
- 3) ☒ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-19 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 1-19 is/are allowed.
- 6) ☐ Claim(s) \_\_\_\_\_ is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 13 December 2005 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                       | 5) <input type="checkbox"/> Notice of Informal Patent Application                       |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input checked="" type="checkbox"/> Other: <u>Notice to Comply</u> .                 |

## **DETAILED ACTION**

### ***Status of the Claims***

1. Amendment of claims 1, 8, and 16 in Applicants' filing of 8/14/2008 is acknowledged. Claims 1-19 are pending and examined herein.

### ***Terminal Disclaimer***

2. The terminal disclaimer filed on 8/14/2008 disclaiming the terminal portion of any patent granted on this application which would extend beyond the expiration date of U.S. Patent No. 6,270,958 has been reviewed and is accepted. The terminal disclaimer has been recorded.

### ***Claim Rejections - 35 USC § 102***

3. Rejection of claims 1-2, 4-6, and 16-19 under 35 U.S.C. 102(b) as being anticipated by DNAVEC Research, Inc. is **withdrawn** in view of amendment to the claims.
4. Rejection of claims 1-2 and 4-6 under 35 U.S.C. 102(b) as being anticipated by Kitazato, *et al.* is **withdrawn** in view of amendment to the claims.

### ***Claim Rejections - 35 USC § 103***

5. Rejection of claims 3, 7-13 and 15 under 35 U.S.C. 103(a) as being unpatentable over DNAVEC Research, Inc. in view of Kimura, *et al.* and Nagai and Kato is **withdrawn** in view of Applicants' arguments.

### ***Double Patenting***

Art Unit: 1648

6. Rejection of claims 1, 4-9, 13, and 16-19 on the ground of nonstatutory double patenting over claims 1-10 of U. S. Patent No. 6,270,958 is **withdrawn** in view of a Terminal Disclaimer filed 8/14/2008.

***Claim Rejections - 35 USC § 112***

7. Rejection of claims 1-19 under 35 U.S.C. 112, first and second paragraphs, as not being enabled and being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention is **withdrawn** in view of Applicants' arguments and amendment of claims 1 and 16.

***Compliance with Deposit Rules of 37 CFR § 1.808 and 1.809***

8. Applicants' amendment of the Specification satisfies the deposit requirements of 37 CFR § 1.808.

***Specification***

9. The Specification is objected to because, as required by 37 CFR 1.78(5)(i), Applicants are required to reference to Applications for which Applicants claim benefit. For example, the Specification must be amended in the manner similar to the following: "This is a U.S. National application of PCT/US04/18783, which claims the benefit of provisional application 60/476521.".

***Drawings***

10. New corrected drawings in compliance with 37 CFR 1.121(d) are required in this application because Figure 3 includes nucleic acid sequence information without reference to required sequence listing, e.g., SEQ ID No. 1. Applicant is advised to employ the services of a competent patent draftsman outside the Office, as

Art Unit: 1648

the U.S. Patent and Trademark Office no longer prepares new drawings. The corrected drawings are required in reply to the Office action to avoid abandonment of the application. The requirement for corrected drawings will not be held in abeyance.

***Allowable Subject Matter***

11. Claims 1-19 are allowed.
12. This application is in condition for allowance except for the following formal matters:

Figure 3 illustrates an embodiment of Applicants' invention by including a nucleic acid sequence. Such inclusions of sequence data requires a sequence listing in compliance with 37 CFR 1.821-1.825 (please see attached Notice to Comply).

Prosecution on the merits is closed in accordance with the practice under *Ex parte Quayle*, 25 USPQ 74, 453 O.G. 213, (Comm'r Pat. 1935).

A shortened statutory period for reply to this action is set to expire **TWO MONTHS** from the mailing date of this letter.

13. Any inquiry concerning this communication or earlier communications from the examiner should be directed to STUART W. SNYDER whose telephone number is (571)272-9945. The examiner can normally be reached on 9:00 AM-5:30 PM. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Bruce R. Campell can be reached on (571) 272-0974. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Art Unit: 1648

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Mary E Mosher/  
Primary Examiner, Art Unit 1648

Stuart W Snyder  
Examiner  
Art Unit 1648

SWS